

REMARKS

The present application has been reviewed in light of the Office Action dated December 9, 2008. Claims 1, 3, 5, 6, and 9-11 are presented for examination, of which Claims 1 and 9 are in independent form. Claims 1, 3, and 9 have been amended to define aspects of Applicants' invention more clearly. Favorable reconsideration is requested.

Claim 9 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants have carefully reviewed and amended Claim 9, as deemed necessary, to ensure that it conforms fully to the requirements of Section 101, with special attention to the points raised in section 8 of the Office Action. It is believed that the rejection under Section 101 has been obviated, and its withdrawal is therefore respectfully requested.

The Office Action states that Claims 1, 3, 5, 6, and 9-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,578,808 (*Taylor*) in view of U.S. Patent Appln. Pub. No. 2004/0044627 (*Russell et al.*). Applicants submit that independent Claims 1 and 9, together with the claims dependent therefrom, are patentably distinct from the cited prior art for at least the following reasons.

Notable features of amended Claim 1 include “adding, to a second database, a copy of the first data set, the second database being remote from the RF transaction device, and being in communication with a user interface via a communication network,” “modifying, by the first data set owner, the copy of the first data set via the user interface,” “storing in a queue the modified copy of the first data set,” “determining that the RF transaction device is in communication with a read/write device,” and “overwriting, via the read/write device after the determining, the first data set on the RF transaction device with the modified copy of the first data set stored in the queue.” Support for the amended features may be found in the specification

in at least paragraphs [0121] and [0122]. By virtue of these features, an owner of a transaction device data set (e.g., an issuer of credit) can modify the data set without currently possessing the transaction device. This is especially beneficial for a transaction device that contains data sets from multiple issuers because, inevitably, one of the issuers of credit will not have issued (and thus may not ever had physical possession of) the physical card. In addition, the remote copy of the transaction device data set can be used to repair or replace the transaction device if the device ever becomes damaged.

As best understood by Applicants, *Taylor* relates to a multi-application data card that substitutes for multiple single-application data cards. Each application on the data card contains multiple data fields, where each issuer can only access fields associated with their application, and cannot access fields associated with applications of other issuers. Apparently, rather than considering processes related to configuring (e.g., overwriting) the data cards, *Taylor* focuses on processes associated with completing a transaction using the card.

Nothing has been found in *Taylor* that is believed to teach or reasonably suggest the “adding,” “modifying,” “storing,” “determining,” and “overwriting,” features mentioned above in connection with Claim 1. At the very least, Applicants submit that *Taylor* fails to suggest maintaining copies of transaction device data fields, much less modifying the copies. Indeed, the only storing of data fields found in *Taylor* is the storing of the fields onto the transaction card itself.

Accordingly, for at least these reasons, Applicants submit that Claim 1 is patentable over *Taylor*.

Russell et al. is cited in the Office Action for disclosing an RF transaction device. *Russell et al.* is not understood, however, to remedy the above-mentioned deficiencies of *Taylor*.

As best understood by Applicants, *Russell et al.* relates to methods for providing secure transactions. *Russell et al.* discloses that in order to complete a transaction, a payer must convey to a payee (1) payment information, (2) account data, and (3) a designation associated with a personal identifying device (PID) that is used to authenticate that the payer is authorized to use the specified account. The only configuring of data that Applicants have found in *Russell et al.* requires the PID to be physically in possession. That is, *Russell et al.* is not understood to provide for maintaining copies of PID data (let alone copies remote from the PID) and remotely updating data on the PID by modifying the copies.

Nothing has been found in *Russell et al.* that is believed to teach or reasonably suggest the “adding,” “modifying,” “storing,” “determining,” and “overwriting,” features mentioned above in connection with Claim 1.

Accordingly, Applicants submit that Claim 1 is patentable over the cited art, whether considered individually, or in any permissible combination. Withdrawal of the rejection under 35 U.S.C. § 103(a) is therefore respectfully requested.

Independent Claim 9 includes features similar to those discussed above in connection with Claim 1. Therefore, Claim 9 also is believed to be patentable for at least the same reasons.

The other rejected claims in this application depend from one or another of independent claims 1 and 9, and therefore are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

No petition to extend the time for response to the Office Action is deemed necessary for this Amendment. If, however, such a petition is required to make this Amendment timely filed, then this paper should be considered such a petition and the Commissioner is authorized to charge the requisite petition fee to Deposit Account 50-3939.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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